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| 09/748,496      | 12/22/2000  | Albert S. Thompson III | P-3001.2/THO        | 4087             |

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| EXAMINER |
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YOUNG, JOHN L

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| ART UNIT | PAPER NUMBER |
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3622

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DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/748,496**

Applicant(s)  
**Thompson III**

Examiner  
**John Young**

Art Unit  
**3622**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 3, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-17 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

*[Handwritten signature]*  
12-19-03

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**SECOND ACTION REJECTION****DRAWINGS**

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

**CLAIM REJECTIONS (Mixed Class Claim) — 35 U.S.C. §101**

2. **Rejections Maintained.**

**CLAIM REJECTIONS — 35 U.S.C. §112 ¶1**

3. **Rejections Maintained.**

**CLAIM REJECTIONS (Mixed Class Claim) — 35 U.S.C. §112 ¶2**

4. **Rejections Maintained.**

**CLAIM REJECTION — 35 U.S.C. §112 ¶2****Improper Markush Group**

5. **Rejection Withdrawn.**

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**Information Disclosure Statement References Not Considered**

**6. Objection Maintained.**

**CLAIM REJECTIONS — 35 U.S.C. §103(a)**

**7. Rejections Maintained.**

**The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.**

8. Claims 10-11 & 13-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Galbo 5,062,541 (11/05/1991) (herein referred to as “Galbo”) in view of Harris 6,230,549 (05/15/2001 [US f/d: 4/25/2000] (herein referred to as “Harris”).

As per claim 10, Galbo (FIG. 1; FIG. 2; FIG. 4) shows: “providing an automotive vehicle having a fuel tank and a fuel tank fill tube in fluid communication with the fuel tank. . . .”

Galbo (FIG. 4; and col. 2, ll. 1-7) discloses a gas filler cap with a message on the cap designed to remind the consumer “*a mechanism with the cap to deliver a reminder message to a person removing the cap from the filler tube. . . .*” (see Galbo (col. 2, ll. 1-7)). The Examiner interprets the disclosure of Galbo (FIG. 1; FIG. 2; FIG. 4) as “providing the message-bearing element on the replacement gas cap. . . .”

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Galbo lacks an explicit recitation of “providing a message-bearing element bearing a message worded to remind an automotive vehicle operator to accomplish a task related to vehicle emission reduction. . . .” even though Galbo reasonably suggests same.

Galbo (FIG. 1; FIG. 2; FIG. 4) reasonably suggests: “A method for reducing emissions from automotive vehicles. . . .” and “providing a replacement gas cap configured to close the fuel tank fill tube, the replacement gas cap including a good quality sealing surface capable of sealing the fuel tank fill tube against fuel vapor leakage. . . .”

(NOTE: It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. V. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989)).

Galbo lacks an explicit recitation of “A method for reducing emissions from automotive vehicles. . . .” and “providing a replacement gas cap configured to close the fuel tank fill tube, the replacement gas cap including a good quality sealing surface capable of sealing the fuel tank fill tube against fuel vapor leakage. . . .” even though Galbo suggests same.

Galbo lacks an explicit recitation of “removing any existing gas cap from the fuel tank fill tube; and installing the replacement gas cap in a sealing relationship on the fuel tank fill tube.”

Harris (FIG. 14) discloses filler caps with emission test messages on the filler caps: “*FAIL*” and “*PASS*.”

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Harris (FIG. 14; col. 1, ll. 16-20; col. 1, ll. 34-67; the ABSTRACT; and whole document) discloses: “providing a replacement gas cap configured to close the fuel tank fill tube, the replacement gas cap including a good quality sealing surface capable of sealing the fuel tank fill tube against fuel vapor leakage. . . .” and “removing any existing gas cap from the fuel tank fill tube; and installing the replacement gas cap in a sealing relationship on the fuel tank fill tube.”

Harris (col. 1, ll. 34-67; the ABSTRACT; FIG. 14; and whole document) reasonably suggests “A method for reducing emissions from automotive vehicles. . . .” and “providing a replacement gas cap configured to close the fuel tank fill tube, the replacement gas cap including a good quality sealing surface capable of sealing the fuel tank fill tube against fuel vapor leakage. . . .”

Harris proposes gas cap replacement and emission protection and message modifications that would have applied to the system of Galbo. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of Harris with the teachings of Galbo because such combination would have provided “*a mechanism with the cap to deliver a reminder message to a person removing the cap from the filler tube. . . .*” (see Galbo (col. 2, ll. 1-7)) and because such combination would have provided means “*to seal properly the fuel tank filler necks of vehicles so that, for environmental reasons, fuel vapors are prevented from leaking into the atmosphere. . . .*” (see Harris (col. 1, ll. 16-20)).

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As per claim 11, Galbo in view of Harris shows the method of claim 10. (See the rejection of claim 10 supra).

Galbo (FIG. 4; and col. 2, ll. 1-7) discloses “providing a message-bearing element includes the step of providing a message recommending accomplishment of . . . purchasing a product. . . .” (i.e., purchasing diesel fuel).

Galbo lacks an explicit recitation of “providing a message-bearing element includes the step of providing a message recommending accomplishment of one or more tasks selected from off[sic] a group of tasks including: replacing the gas cap, accomplishing vehicle maintenance, purchasing a product, purchasing a service, inspecting the vehicle for safety problems, and testing vehicle emission levels.”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Galbo (FIG. 4; and col. 2, ll. 1-7) in view of the disclosure of Harris (FIG. 14; col. 1, ll. 16-20; col. 1, ll. 34-67; the ABSTRACT; and whole document) would have been selected in accordance with “providing a message-bearing element includes the step of providing a message recommending accomplishment of one or more tasks selected from off[sic] a group of tasks including: replacing the gas cap, accomplishing vehicle maintenance, purchasing a product, purchasing a service, inspecting the vehicle for safety problems, and testing vehicle emission levels. . . .” because such selection would have provided “*a mechanism with the cap to deliver a reminder message to a person removing the cap from the filler tube. . . .*” (see Galbo (col. 2, ll. 1-7)) and because such selection would have provided means “*to seal properly the fuel tank filler*

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*necks of vehicles so that, for environmental reasons, fuel vapors are prevented from leaking into the atmosphere. . . .*" (see Harris (col. 1, ll. 16-20)).

As per claims 13-17, Galbo in view of Harris shows the method of claim 10 and the methods of subsequent base claims depending from claim 10.

Galbo lacks an explicit recitation of the elements and limitations of claims 13-17 even though Galbo in view of Harris reasonably suggests all of the elements and limitations of claims 13-17.

"Official Notice" is taken that both the concepts and the advantages of the elements and limitations of claims 13-17 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious to include all of the elements and limitations of claims 13-17 because such inclusion would have provided "*a mechanism with the cap to deliver a reminder message to a person removing the cap from the filler tube. . . .*" (see Galbo (col. 2, ll. 1-7)) and because such inclusion would have provided means "*to seal properly the fuel tank filler necks of vehicles so that, for environmental reasons, fuel vapors are prevented from leaking into the atmosphere. . . .*" (see Harris (col. 1, ll. 16-20)).

#### **NEW CLAIM REJECTION — 35 U.S.C. §103(a)**

**The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.**



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9. Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Galbo in view of Harris.

As per claim 12, Galbo in view of Harris shows the method of claim 10.

Galbo (FIG. 4; FIG. 6; FIG. 1; the ABSTRACT; col. 1, ll. 5-7; col. 1, ll. 37-43; col. 2, ll. 1-51; and col. 3, ll. 30-67 ) shows elements and limitations that suggest: “providing a message-bearing element includes the step of providing a gas cap cover device on the replacement gas cap, the cover device bearing the message and including a shell configured to be disposed over a portion of a gas cap and a connector supported on the shell and configured to engage the gas cap and cause the gas cap to rotate when the cover device is rotated.”

Galbo lacks an explicit recitation of “providing a gas cap cover device on the replacement gas cap. . . .” It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Galbo (FIG. 4; FIG. 6; FIG. 1; the ABSTRACT; col. 1, ll. 5-7; col. 1, ll. 37-43; col. 2, ll. 1-51; and col. 3, ll. 30-67 ) would have been selected in accordance with “providing a gas cap cover device on the replacement gas cap. . . .” because selection of such features would have provided “*a mechanism with the cap to deliver a reminder message to a person removing the cap from the filler tube. . . .*” (see Galbo (col. 2, ll. 1-7)) and because such selection would have provided means “*to seal properly the fuel tank filler necks of vehicles so that, for environmental reasons, fuel vapors are prevented from leaking into the atmosphere. . . .*” (see Harris (col. 1, ll. 16-20)).

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### RESPONSE TO ARGUMENTS

10. Applicant's arguments (Amendment B, filed 10/03/2003, paper #4) have been fully considered but they are not persuasive for the following reasons:

In response to Applicant's arguments (Amendment B, paper#4, p. 6) which suggests that the prior Office action rejection relies on impermissible hindsight, it is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989)). Furthermore, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the prior Office Action relies on knowledge generally available to one of ordinary skill in the art and asserts that the modified teachings of the references relied upon in conjunction with the knowledge of one of ordinary skill in the art either teaches and/or suggests all of the elements and limitations of the instant invention. "The test for an implicit showing is what the

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combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’ *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).” (See MPEP 2134.01).

In response to Applicant’s arguments (Amendment B, paper#4, pp. 6-7) which suggests that there is no suggestion that would have motivated one of ordinary skill in the art to combine and/or modify the referenced teachings, it is well settled that “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” (See MPEP 707.02(j)).

Also, it is well settled that in order to establish motivation to modify or combine references, “it is not necessary that a reference actually suggest changes or possible improvements which Applicant made.” (See *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). In other words the rationale for motivation to modify or combine references does not have to suggest the same motivation of the Applicant.

Also, it is well settled in the law that “‘There are three possible sources for motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.’ *In re Ruffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). . . .” (See MPEP

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2143.01). Furthermore, the Examiner relies on knowledge generally available to one of ordinary skill in the art and asserts that the modified teachings of the applied reference in conjunction with the knowledge of one of ordinary skill in the art either teach or suggest all of the elements and limitations of the instant invention. “‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’ *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).” (See MPEP 2134.01).

In the prior Office Action obviousness rejections, the Examiner meets the requirements of the motivation test for combining the prior art references by quoting from the references cogent reasons (i.e., motivation) to combine and/or modify the teachings. Furthermore, the Examiner relies on knowledge generally available to one of ordinary skill in the art and asserts that the teachings of the references combined with the knowledge of one of ordinary skill in the art either teaches or suggests all of the elements and limitations of the instant invention. Therefore, based upon the above considerations, *prima facie* obviousness is established in the prior Office action based upon a proper showing of motivation to combine the prior art references to come up with Applicant’s invention.

As per claims 13-17, Applicant's arguments (Amendment B, filed 10/03/2003,

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paper #4, pp. 8-9) fail to present an appropriate challenge to the taking of Official/Judicial Notice because Applicant's arguments do not contain a per se demand for references in support of the officially noticed evidence. (MPEP 2144.03).

**Therefore, the "Official Notice" or common knowledge or well-known in the art statement is taken to be admitted prior art because Applicant's traversal is inadequate, and no further references in support of the official notice evidence are required.**

#### CONCLUSION

11. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

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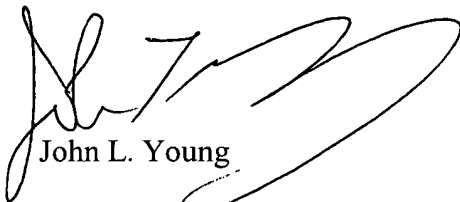
Hand delivered responses may be brought to:

Seventh floor Receptionist  
Crystal Park V  
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Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'John L. Young', with a large, stylized flourish extending from the end of the signature.

Primary Patent Examiner

December 19, 2003